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SUGHRUE, MION, ZINN, MACPEAK & SEAS
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Washington, DC 20037

EXAMINER

FLEURANTIN, JEAN B

ART UNIT PAPER NUMBER

2162

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,342

Applicant(s)

SUGIYAMA, AKIHIRO

Examiner

JEAN B. FLEURANTIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1-21 remain pending for examination.

Response to Applicant' Remarks

2. Applicant's arguments filed 5 August 2004 have been fully considered but they are not persuasive for the following reasons: In response to applicant's argument on pages 24 and 25, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hecksel does not explicitly disclose the claimed to-be-registered information generating section which receives specification information from a plurality of companies from a plurality of company terminals which are connected through a network and used by the respective companies, the specification information received from each company specifying at least one data item required for user registration. However, JP '996 discloses the claimed registration/reference tool (15) for users build into the interior of this software will be installed, and a user (10) will be used for activity registration of software (14a) if it is going to installed (A) software 14(a), and the registration information about software are

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stored in the master database (17) inside the user registration center (13) through a network (12), (page 2, (0017) to page 3, (00202; and a user registration is required and it is also required to grasp a user' utilization situation, the information as which the user was required is written down in the postcard attached to each product in the user registration of the software as such a computer related product, moreover even when it is registration of the product with which the online registration method is used, it is a different format for every provider of a product and it is required to input similar information each time, (see page 1, (0002j, (0003) and (0004)). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combined teachings of Hecksel and JP '996 with to-be-registered information generating section which receives specification information from a plurality of companies from a plurality of company terminals which are connected through a network and used by the respective companies, the specification information received from each company specifying at least one data item required for user registration. Such modification would allow the teachings of Hecksel and JP '996 to provide the cost of user registration operation and user service operation can be reduced, (see JP :996, page 9, (0074)).

As per Applicant's argument on page 24, that "the prior art reference or combination of references must teach or suggest all the limitations of the claims." Respectfully, Applicant(s) appear(s) to misinterpret the guidance given under MPEP 2142. In particular, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

There are numerous court decisions supporting the position given above. The issues of obviousness is not determined by what the references expressly state but what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davis* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988)(citing *In re Ialu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (I) obviousness does not require absolute predictability;
- (II) non-preferred embodiments of prior art must also be considered; and
- (III) the question is not express teaching of references; but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

In response to applicant's argument on page 25, that the Hecksel and JP '996 references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ... that is received from a software company terminal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument on page 26, that "does not teach or suggest the receiving of individualized specification information from a plurality of companies, wherein the individualized specification information specifies the data needed by each company for registering that company's portion of a multi-component product." It is submitted that Hecksel discloses a system and method for accessing previously stored registration information to assist a user in a current software program registration, the system may advantageously utilize existing registration information associated with a matching software program to populate data fields presented to the user, this saves the user from having to independently ascertain the information (see col. 2, lines 25-31)

Applicant(s) stated on page 26, that "the user registration tool does not send individualized specification information from providers to a registration information generating section" It is submitted that Hecksel discloses the claimed maintains a variety of information to enable multiple registrations (see col. 2, lines 3-5).

MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in

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the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the last Office Action was proper.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,151,707 issued to Hecksel et al. (hereinafter "Hecksel") in view of JP Patent No. 10-301996 issued to Call (hereinafter "JP '996").

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As per claims 1 and 11, Hecksel discloses a user registration supporting system which supports a user, who uses a multi-component product including a plurality of products provided by a plurality of companies, in applying for user registration for the plurality of products (see col. 1, lines 12-20 and col. 1, line 66 to col. 2, line 6), "said system comprises a user-information database which stores user information including a plurality of data items and regarding the user" as registration software program may access a memory in the form of any volatile or non-volatile storage and retrieval device on computer, memory may include a variety of registration information and instructions to assist in operation of registration software program, throughout this document, the term registration information" refers to any information relating to characteristics of the user, characteristics of system, usage statistics, responses to previous requests for user data, answers to survey questions, registration profile data, (see col. 4, lines 3-12);

"a user-information providing section which provides said user-information database with the user information" as a means for modifying registration information associated with a particular software program, which presenting the user with survey questions or marketing information associated with software program, collecting statistics relating to the use of software program" (see col. 4, lines 22-26); and

"to-be-registered information generating section which receives individualized specification information for specifying the at least one data item required by a plurality of companies for the user registration from a plurality of company terminals which are connected through a network and used by the respective companies, the individualized specification extracts at least one data item specified by each individualized the

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specification information, from the user information stored in said user-information database, and generates to-be-registered information used by each of the plurality of companies for the user registration," as means for accessing previously stored registration information to assist a user in a current software program registration, (see col. 2, lines 24-26), and

"wherein said system can generate the to-be-registered information for the plurality of companies at once, based on the user information" as system may generate the chronology table as it processes session data, or the chronology table may have been previously created and stored in registration profile during initial registration of software program (34a), (see col. 13, lines 27-31). Hecksel does not explicitly disclose a to-be-registered information generating section which receives specification information from a plurality of companies from a plurality of company terminals which are connected through a network and used by the respective companies, the specification information received from each company specifying at least one data item required for user registration. However, JP '996 discloses registration/reference tool (15) for users build into the interior of this software will be installed, and a user (10) will be used for activity registration of software (14a) if it is going to installed (A) software 14(a), and the registration information about software are stored in the master database (17) inside the user registration center (13) through a network (12), (page 2, (0017) to page 3, (00202; and a user registration is required and it is also required to grasp a user' utilization situation, the information as which the user was required is written down in the postcard attached to each product in the user registration of the software as such

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a computer related product, moreover even when it is registration of the product with which the online registration method is used, it is a different format for every provider of a product and it is required to input similar information each time, (see page 1, (0002j, (0003) and (0004)). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combined teachings of Hecksel and JP '996 with a to-be-registered information generating section which receives specification information from a plurality of companies from a plurality of company terminals which are connected through a network and used by the respective companies, the specification information received from each company specifying at least one data item required for user registration. Such modification would allow the teachings of Hecksel and JP '996 to provide the cost of user registration operation and user service operation can be reduced, (see JP :996, page 9, (0074)).

As per claim 2, in addition to claim 1, Hecksel further discloses, "a company information database which stores specification information" as the content of registration information maintained in memory (26), (see col. 7, lines 46-60).

As per claims 3 and 13, Hecksel further discloses, "comprising a user registration section which registers the to-be-registered information for each of the plurality of companies" as software application that assists users in registering various software programs (34) with their respective publishers "companies", (see col. 4, lines 54-56), and col. 3, lines 35-42.

As per claims 4 and 12, the limitations of claims 4 and 12 are rejected in the analysis of claim 1, and these claims are rejected on that basis.

As per claims 5, 6, 15 and 16, in addition to the discussion in claim 1, Hecksel further discloses "wherein said user information includes identification information for identifying the multi-component product used by the user" as the method includes a section (300) "figure 3a" to generate a list of software programs residing on, or accessible to computer (11), a section (350) "figure 3b" to identify a matching software program, and a section (380) "figure 3c" to complete the registration session based on information associated with the matching software program, (see col. 9, lines 30-36);

"said company-information database stores information regarding the plurality of companies providing the products according to multi-component product", (see col. 7, line 6 to col. 8, line 12).

As per claims 7, in addition to claim 1, Hecksel further discloses "sends the to-be-registered information generated by said to-be-registered information generating section to each of the company terminals" as the software registration system automatically generates a list of available communication methods for presentation to the user, (see col. 3, lines 2-15).

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As per claim 8, in addition to claim 1, Hecksel further discloses "a user-information providing section provides said user-information database with the user information which is received by said communication" as remote server that receives, stores and distributes information among a variety of remote devices, (see col. 5, lines 3-8).

As per claims 9 and 19, in addition to claim 1, Hecksel further discloses, "wherein the user information is correction information which is formed by correcting the user information stored in said user-information database" as post-registration activity periods may be stored in configuration files to promote modification of registration and marketing data as updates become necessary without requiring modification to the registration software program, (see col. 2, lines 62-65).

As per claim 10, the limitations of claim 10 are rejected in the analysis of claims 1 and 8, and this claim is rejected on that basis.

As per claim 14, in addition to claim 1, Hecksel further discloses, "wherein said generating includes detecting that new user information is stored in a user-information database, and generating to-be-registered information from the new user information" as the software registration system automatically generates a list of available communication methods for presentation to the user, (see col. 3, lines 2-15).

As per claim 17, Hecksel discloses the claimed subject matter except the claimed sending the to-be-registered information which is generated by said generating to a plurality of company terminals which are used respectively by the plurality of companies providing the products, through a network. However, JP '996 discloses registration/reference tool (15) for users build into the interior of this software will be installed, and a user (10) will be used for activity registration of software (14a) if it is going to installed (A) software 14(a), and the registration information about software are stored in the master database (17) inside the user registration center (13) through a network (12), (page 2, (0017) to page 3, (0020). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combined teachings of Hecksel and JP '996 with sending the to-be-registered information which is generated by said generating to a plurality of company terminals which are used respectively by the plurality of companies providing the products, through a network. Such modification would allow the teachings of Hecksel and JP '996 to provide the cost of user registration operation and user service operation can be reduced, (see JP '996, page 9, (00741).

As per claim 18, in addition to claim 17, Hecksel further discloses "wherein said storing includes providing the user-information database with the user information which is received from the user terminal by said receiving", (see col. 5, lines 36-42).

As per claim 20, the limitations of claim 20 are rejected in the analysis of claims 1 and 7, and this claim is rejected on that basis.

As per claim 21, in addition to claim 1, Hecksel discloses a computer readable recording medium which records a program for controlling a computer to execute (see col. 2, lines 24-27),

"storing user information including a plurality of data items regarding a user who uses a multi-component product including a plurality of products provided by a plurality of companies" as the selected registration information includes registration information and/or responses to survey questions provided by a user or otherwise obtained during a previous registration session for a matching software program, designated by the reference numeral (34n), software programs (34) are considered matching if they share a common attribute, such as the user, the publisher "company" of the software program or common registration information, the term "publisher" refers to the technology provider, software publisher, information gatherer, company, or other entity having an interest in distributing, collecting, maintaining, and utilizing registration and/or marketing information related to software program (34), (see col. 5, lines 29-42); and

"extracting a data item specified by each individualized the specification information, from the stored user information" as means for retrieving selected registration information stored in previous registration file (28) within memory (26) (see col. 5, lines 26-33), and "generating to-be-registered information used by each of the plurality of companies for the user registration" as a system and method for accessing

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previously stored registration information to assist a user in a current software program registration, (see col. 2, lines 24-26).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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CONTACT INFORMATION

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jean Bolte Fleurantin

December 28, 2004

Mohamed Ali
Primary Examiner
Art Unit 2167